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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,487

03/02/2004

Alan Franklin

74119-004

1879

29493

7590

05/04/2006

HUSCH & EPPENBERGER, LLC

190 CARONDELET PLAZA

SUITE 600

ST. LOUIS, MO 63105-3441

EXAMINER

WITCZAK, CATHERINE

ART UNIT

PAPER NUMBER

3767

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b> 10/791,487	<b>Applicant(s)</b> FRANKLIN, ALAN	
	<b>Examiner</b> Catherine N. Witczak	<b>Art Unit</b> 3767	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/9/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 4, 6, 8, 10, 11, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Yaacobi (US 6,416,777).

Claims 1, 4, 8, 10, 11, and 15: Yaacobi discloses in Figures 9 and 10 a trans-scleral device attaching to the scleral surface comprising an insert stabilizer (50) having an interlock opening (20) a replaceable implant (46) having a reservoir (81), an interlock tab (87), and an anti-angiogenesis factor in the form of a pellet (column 6, lines 10-23) in the reservoir (81) (column 7, lines 1-27).

Claim 6: Yaacobi discloses in column 8, lines 59-63 refilling the device by disengaging the replaceable implant while leaving the stabilizer attached.

Claim 16: Yaacobi discloses in Figure 9 the stabilizer (50) having a first end in which the interlock opening (20) is disposed, and a second end (25) having a relatively narrower width the first end.

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*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 9, 14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaacobi as modified by Sponsel et al (US 2004/0198829).

Yaacobi discloses in Figures 9 and 10 a trans-scleral device attaching to the scleral surface comprising an insert stabilizer (12) having an interlock opening (20) a replaceable implant (46) having a reservoir (81), an interlock tab (87), and an anti-angiogenesis factor in the form of a pellet (column 6, lines 10-23) in the reservoir (81) (column 7, lines 1-27). Yaacobi further discloses in column 8, lines 59-63 refilling the device by disengaging the replaceable implant while leaving the stabilizer attached.

Yaacobi discloses the claimed invention except for the use of trans-scleral administration of CAI for angiogenesis treatment. Sponsel et al teach that known to use administer CAI trans-sclerally in paragraphs 0112 and 163 to provide an effective way of administering a beneficial anti-angiogenesis factor. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Yaacobi with trans-scleral administration of CAI as taught by Sponsel et al, since such a modification would provide the method with an effective way with administering a beneficial anti-angiogenesis factor.

3. Claims 3, 5, 7, 12, 13, 17, 18, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sponsel et al as applied to claims 2, 9, 14, and 21 above, and further in view of De Carvalho (US 2005/0113806).




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Yaacobi as modified by Sponsel et al discloses the claimed invention expect for the reservoir being refillable through being connected to an injection port and an insert stabilizer comprising an eyelet for attaching the device through suturing. De Carvalho teaches that it is known to use a refillable reservoir connected to an injection port and an insert stabilizer comprising an eyelet for attaching the device through suturing as set forth in Figures 5 and 6 in order to allow safe refill of the reservoir (paragraph 0073) and for attachment of the device to the eye. It would have been obvious to one having ordinary skill in the art at the time the invention was made o modify the method as taught by Yaacobi and modified by Sponsel et al with a refillable reservoir connected to an injecting port an taught by De Carvalho, since such a modification would provide the method with a way of safely refilling the reservoir and an eyelet for attachment of the device to the eye.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine N. Witczak whose telephone number is (571) 272-7179. The examiner can normally be reached on Monday through Friday, 8-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
9/27/06

KEVIN SIRMONS  
PRIMARY EXAMINER

